REMARKS

Claims 1-2, 5-23, and 37-50 are pending in the application. By this paper, claims 1, 19, 37, and 44 have been amended. No new matter is added by these amendments. Reconsideration and allowance of the application in light of the amendments and arguments herein is respectfully requested.

Interview Summary

Representatives of the Applicants, Nair Flores and David Ishimaru, and attorneys for the Applicants, Nathan Greene and Scott Brim, conducted an in-person examiner interview on June 10, 2008. Primary Examiner Hani Kazimi also participated along with Muriel Tinkler. Applicants thank the examiners for their time and the opportunity to discuss the application. Discussed were the claims as currently amended, and Examiners Kazimi and Tinkler suggested further claim amendments to overcome the 35 U.S.C. § 112 rejection as well as any potential 35 U.S.C. § 101 rejections. No agreement was reached on any of the claims.

35 U.S.C. § 112 Rejections

Claims 1, 19, 37, and 45 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. According to the Office Action, the specific terms "without advertiser intervention" are not mentioned in the specification. The Applicants respectfully note that claim 45 does not include "without advertiser intervention" and, therefore, the § 112 rejection does not apply. This language has also been deleted out of claims 1, 19, and 37, and accordingly, the Applicants respectfully request that the rejection be withdrawn.

Furthermore, as discussed during the in-person examiner interview, amendments to claims 1, 19, and 37 tie the methods and system of those claims to computer implementation, using language from the specification to clarify that the same include automated processes. These amendments should also overcome any potential 35

U.S.C. § 101 rejection the Examiner could contemplate under recent guidance from the PTO's Deputy Commissioner for Patent Examiner Quality.

Because no other rejections have been made, for instance, under §§ 102, 103 of 35 United States Code, the Applicants respectfully submit that claims 1, 19, 37, and 45 are in condition for allowance and should be allowed forthwith. Likewise, claims 2, 5-18, 20-23, 38-43, and 46-50 should also be allowed by virtue of their dependency from claims 1, 19, 37, and 45, respectively.

35 U.S.C. § 103 Rejections

The Office Action rejects only claim 44 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,078,866 ("Buck") in view of U.S. Patent No. 6,026,383 ("Ausubel"). This rejection, however, fails to make a *prima facie* case of obviousness because these references combined fail to disclose all the features of claim 44. MPEP § 2142 ("The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness"). For sake of thoroughness, and to expedite allowance, the Applicants distinguish over Buck in view of Ausubel.

In paragraph 7 of the current Office Action, page 4, it briefly lists what the Office Action understands that Buck discloses, but without any apparent relation to the claim language. Indeed, the Office Action does not state where in Buck and/or Ausubel the following claim features are disclosed:

> updating one or more selected listings of the database in response to a desired rank and bid cap received from an advertiser using the advertiser access page, the selected search listings being re-ordered in accordance with the received desired rank and bid cap.

The Office Action cursorily points to element 47 of Figure 2B for "updating search listings," but this element only makes reference to a manual button for individual listings, not instructions from a computer readable storage medium executed by a processor to update selected listings in response to a desired rank and a bid cap. Buck makes no mention of a bid cap, or a maximum rank that may be affiliated with a bid cap. Furthermore, nowhere does Buck disclose "the selected search listings being re-

ordered in accordance with the received desired rank and bid cap" according to the set of instructions.

The Applicants respectfully note that "denominated value" referred to in Buck refers to a subscription fee set by an advertiser, such as based on a monetary value or a point system. Col. 4, lines 13-28. That is, "denominated value" has nothing to do with a bid cap. Buck discloses that "[s]ubscribers can monitor the rankings of their listings in relation to others, and can modify their rankings by raising or lowering their subscription fees, through a subscription monitoring interface provided with the listing server." Id. This discloses no more than that discussed as the problem to be solved in the Applicant's application as the advertisers would have to manually monitor and adjust their own listings according to market changes.

Furthermore, Buck fails to disclose:

> providing a response message to the affiliated web service provider for forwarding to the searcher if the search query matches one of the selected search listings, the response message including a search result list including the one selected search listing positioned as re-ordered in accordance with the received bid cap and the desired rank.

Buck fails to disclose these features at least because it does not disclose "the response message including a search result list including the one selected search listing positioned as re-ordered in accordance with the received bid cap and the desired rank" for similar reasons as discussed above.

Finally, Ausubel fails to disclose "determining if a tie condition makes a desired rank unavailable for a respective selected search listing, and if so, to increment a bid amount for the respective selected search listing" (emphasis added). Indeed, Ausubel does not refer to a "desired rank" at all. Ausubel discloses "using either a deterministic or a random method of breaking ties." Col. 9, lines 55-56, 63-64. Deterministic simply means "not random," or that the method of breaking ties is based on some function in relation to the other bids. See, e.g., http://economics. about.com/library/glossary/bldef-deterministic.htm. Nowhere does Ausubel disclose that a bid amount is incremented for a search listing that is tied with another one. Ausubel merely acknowledges that tie

conditions may exist in an online auction, but does not give any help in resolving tie conditions.

Furthermore, there is no motivation to combine Ausubel with Buck. Buck is drawn to an internet site/database searching and listing service based on monetary ranking of site listings. Listings are ranked according to the denominated value of an advertiser's subscription fees, which may be based on monetary value or some type of point system. Col. 4, lines 23-28. *Actual payment for or renewal of* the subscription service takes place on a periodic basis, and is therefore, unrelated to positioning of an advertiser's ranking when updating a subscription fee. See Col. 4, lines 54-59. This passage also refers generally to "economic factors that justify their advertisement costs for the Web site" for repositioning of their listing. Id. "Economic factors" is broad, and has little to do with a conventional auction "bid."

In contrast, Ausubel discloses an actual, automated auction for multiple objects for which high bidders are expected to pay value when they win the auction for a particular object. Col. 2, lines 28-32. The "bids" in Ausubel have no relation to the denominated value subscription fees monitored and updated by advertisers in the internet/database search system of Buck. Also, the cited paragraph in Ausubel relates to a situation in which a bid consists of a list of specific objects and a price offered for each object, or a quantity of objects and a price offered for that quantity. Col. 9, lines 50-60. Again, these bids are very different from the subscription fees paid in Buck.

For at least these reasons, claim 44 is patentable over Buck, Ausubel, and a combination of the same. All pending claims are believed to be patentable.

Conclusion

The Applicants respectfully point out that this application is nearly seven years old and submit that prosecution has been unnecessarily extended by inadequate, piecemeal office actions. The Applicants, therefore, respectfully request that further actions be expedited to move this application to allowance. Indeed, the application is submitted to be in condition for allowance. If a telephone interview can expedite this

process to clarify the claims or the perceived scope of the cited art, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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